

Notice of Allowability

Application No.

10/798,692

Examiner

Dr. Kailash C. Srivastava

Applicant(s)

BECKER ET AL.

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to communication filed 03 October 2007.
2. ☒ The allowed claim(s) is/are 34-40 and 42-47.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 10/03/2007
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Examiner's Comments

1. Response and amendment filed 20 August 2007 to the Office Action mailed 26 March 2007 is acknowledged and entered.
2. In view of remarks and amendment filed 20 August 2007, objection to specification in the Office Action mailed 26 March 2007 is hereby withdrawn.
3. In view of remarks and amendment filed 20 August 2007, following rejections made in the Office Action mailed 26 March 2007 are hereby withdrawn;
 - indefiniteness rejection to Claim 37 under 35 U.S.C. §112, 2nd Paragraph;
 - anticipatory/obviousness rejection to Claim 37 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Starrett et al. (EP 0481 214 A1).
4. In view of search results for prior art from the search conducted 29 October 2007 and amendment filed 20 August 2007, the species election in the election/ restriction mailed 25 July 2006 is hereby withdrawn. Claims 34-40 and 42-47 are examined together as one single invention.

Claims Status

5. Claims 1-33 and 41 have been cancelled.
6. Claims 34-35, 37 and 42-47 have been amended
7. Claims 34-40 and 42-47 are pending and are examined as one single invention.

Information Disclosure Statement

8. The Information Disclosure Statement (i.e., IDS) filed 03 October 2007 has been made of record considered and duly signed Form PTO-1449 is enclosed.

Examiner's Statement of Reasons For Allowance:

9. The following is Examiner's reasons for allowance:

The closest prior art is:

- o Starrett et al. (EP 0 481 214 A1).

Starrett et al., however, teach a compound having a generic structure, rather than the instantly claimed species structure in Claims 34-37. Therefore, the prior art teaches the structure of a broad Genus of compound, rather than the claimed species. Therefore, the above-cited prior art reference can-not anticipate the specific structure instantly claimed in Claims 34-37 (See, *In re Baird*, 29 USPQ 2d1550-Fed Circuit, 1994). Furthermore, the prior art does not teach the chirality of the phosphanate group. In addition, the prior art does not make the claimed structure/composition inherently anticipatory, because the method of preparation of the compound of claimed structure is entirely different than that described in Starret et al (See Starrett et al., Page 7, Line 38 to Page 9, Line 20).

Thus, the above-cited prior art reference does not teach or reasonably suggest a compound/ of the structure/composition having the structure of a compound of claimed invention.

10. Any comments considered necessary by applicants must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

IN THE SPECIFICATION:

Replace paragraph [0045] at page 8 with:


[0045] Figure 3 depicts Tenofovir exposure in PBMCs and plasma upon administration of 10 mg-eq/kg in dogs.

11. Claims 34-40 and 42-47 are allowed.

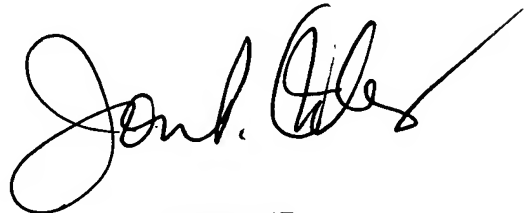
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kailash C. Srivastava, Ph.D.
Patent Examiner
Art Unit 1657
(571) 272-0923

02 November 2007


JON WEBER
SUPERVISORY PATENT EXAMINER